

Application No.: 09/095,365

5

Docket No.: 163852016000

REMARKS

Claims 1-10 and 12-14 are pending. Claims 1 and 12 have been amended. No new matter has been added.

Claims 1, 2, 5 and 14 were rejected under 365 USC 102(e) as being anticipated by Norman, U.S. Patent 5,807,457. This rejection is respectfully overcome.

Claim 1 has been amended to clarify that the wide of the tape is smaller than the width of the sheets onto which the tape is adhered. Further, claim 1 has been amended to clarify that "the marker is adhered to the predetermined sheet by a predetermined pressure force as the predetermined sheet passes through the marker and sheet feeder without pausing the marker and sheet feeder, with one portion of the marker overlapping and in contact with the predetermined sheet and remainder of the marker protruding from the predetermined sheet to indicate a boundary between a sheet or group of sheets and a subsequent sheet or group of sheets." According to that which is recited in claim 1, the boundary indicated by the marker is easily detected by the person who divides the sheets into different groups. Norman does not teach or suggest this feature.

Norman discloses that a group of checks, each check having a tape whose length is the same as the length of the check, are carried to the stack 130 in one mode, and in another group of checks without any tape is carried to the stack 130 in another mode. As can be seen in Fig. 1, the strip 26 and the check 22 are the same width. In other words, the strip will not overlap the check and will not be an adequate boundary between the checks such that it would be easily detectable to a person dividing the checks. Accordingly, the features of claim 1 are not taught or suggested by Norman.

Claims 2, 5 and 14 are allowable at least due to their respective dependencies. Applicants respectfully request that this rejection be withdrawn.

Claims 3, 9 and 10 were rejected under 35 USC 103(a) as being unpatentable over Norman in view of Cavender, U.S. Patent 4,070,220. This rejection is respectfully traversed.

va-47636

Application No.: 09/095,365

6

Docket No.: 163852016000

Claims 3, 9 and 10 depend from claim 1. Since Norman fails to teach or suggest the above-noted features of claim 1, and Cavender also fails to teach or suggest these features, and is not being relied upon as such, these claims are allowable for the same reasons claim 1 is allowable. Applicants respectfully request that this rejection be withdrawn.

Claim 4 was rejected under 35 USC 103(a) as being unpatentable over Norman in view of Lowe, U.S. Patent 3,926,713. This rejection is respectfully traversed.

Claim 4 depends from claim 1. Since Norman fails to teach or suggest the above-noted features of claim 1, and Lowe also fails to teach or suggest these features, and is not being relied upon as such, claim 4 is allowable for the same reasons claim 1 is allowable. Applicants respectfully request that this rejection be withdrawn.

Claim 6 was rejected under 35 USC 103(a) as being unpatentable over Norman in view of Nobile, U.S. Patent 5,390,594. This rejection is respectfully traversed.

Claim 6 depends from claim 1. Since Norman fails to teach or suggest the above-noted features of claim 1, and Nobile also fails to teach or suggest these features, and is not being relied upon as such, claim 6 is allowable for the same reasons claim 1 is allowable. Applicants respectfully request that this rejection be withdrawn.

Claims 7 and 8 were rejected under 35 USC 103(a) as being unpatentable over Norman in view of Nobile. This rejection is respectfully traversed.

Claims 7 and 8 depend from claim 1. Since Norman fails to teach or suggest the above-noted features of claim 1, and Nobile also fails to teach or suggest these features, and is not being relied upon as such, these claims are allowable for the same reasons claim 1 is allowable. Applicants respectfully request that this rejection be withdrawn.

Claims 12 and 13 were rejected under 35 USC 103(a) as being unpatentable over Norman in view of Applicants' admitted prior art. This rejection is respectfully traversed.

va-47636

Application No.: 09/095,365

7

Docket No.: 163852016000

Claim 12 recites the same features discussed above in connection with claim 1. Norman fails to teach or suggest these features. The Applicants' admitted prior art also fails to disclose or suggest these features. Thus, claim 12 is allowable for the same reason claim 1 is allowable. Claim 13 is allowable at least due to its dependency from claim 12. Applicants respectfully request that this rejection be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 163852016000.

Dated: November 12, 2003

Respectfully submitted,

By 
Deborah S. Gladstein

Registration No.: 43,636
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102
(703) 760-7753

va-47636